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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/737,404

Filing Date: December 14, 2000

Appellant(s): INALA ET AL.

Donald R. Boys, Reg. No. 35,074

For Appellant

This is in response to the appeal brief filed 14 October 2004.

EXAMINER'S ANSWER

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments*

Appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. In this section of the brief, Appellant has improperly listed the prosecution history of the present application.

37 CFR 1.192(c)(4) reads: "*Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection."

Appellant has not filed an amendment subsequent to the Final Rejection dated 12 August 2004. Thus, Appellant's statement of the status of amendments is incorrect.

The examiner notes that the Appellant's listing of the prosecution history has neither been considered nor checked for accuracy.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The examiner disagrees with a portion of Appellant's statement of the issues in the brief.

The first issue includes: "if the 'personal' aspects of the system/service of Gershman reads on the personal information stored in the user's profile." See *Appellant's Appeal Brief* – Page 7, last paragraph, first sentence.

Firstly, the examiner has never stated that "the 'personal' aspects of the system/service of Gershman reads on the personal information stored in the user's profile." Secondly, this limitation is not recited in the appealed claims. For these reasons, this issue should not be included in the statement of the issue.

The remainder of Appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The Appellant's grouping of claims in the brief is correct.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 5,983,227	Nazem et al.	11-1999
US 6,029,182	Nehab et al.	02-2000
US 6,356,905	Gershman et al.	03-2002
US 6,078,929	Rao	06-2000
US 6,006,333	Nielsen	12-1999
US 6,687,745	Franco et al.	02-2004

(10) Grounds of Rejection

Claims 1-5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nazem et al., U.S. Patent No. 5,983,227, in view of Nehab et al., U.S. Patent No. 6,029,182, Gershman et al., U.S. Patent No. 6,356,905, and Rao, U.S. Patent No. 6,078,929.

Claim 1:

Nazem discloses an Internet Portal (Nazem, Internet 106; Column 2, Lines 52-57), comprising:

- an Internet-connected server (Nazem, a client-server system 100 . . . obtains the page from a page server 104 via Internet 106; Column 2, Lines 51-57 and Figure 1); and
- a portal software executing on the server (Nazem, Figures 1 and 5, “my.yahoo.com”, a well-known Internet portal), including a summary software

agent (Nazem, Column 3, Lines 15-48, when a page server receives the URL . . . it interprets that as a request for the user's custom summary page).

While teaching "summarizes the retrieved information for delivery to the subscriber" (Nazem, Column 5, Lines 66 through Column 6, Line 12, summaries from each of the major news topics can also be stored in the shared memory and viewed by pressing on the news topic header . . . intelligently display dates 510 customized for a particular user), Nazem fails to expressly disclose maintaining a list of Internet destinations at secure servers, maintaining personal financial accounts for one or more of a plurality of subscribing users, and a summary software agent that automatically logs in to the secure servers on behalf of, and transparent to, the subscribing users at the Portal, retrieves financial information personal to the subscribing users, stores the retrieved financial information at the portal; according to pre-programmed criteria, and summarizes the retrieved information for delivery to the subscribing users.

Nehab teaches the steps of:

- maintaining a list of Internet destinations specifically authorized and specified by a subscribing user (Nehab, Abstract, Lines 1-5, a World Wide Web site data retrieval system . . . stored Web site address information); and
- the summary software agent automatically logs in to the secure server on behalf of, and transparent to the subscribing users, according to data stored for the subscribing users at the Portal, retrieves financial information personal to the subscribing users, stores the retrieved financial information at the portal;

according to pre-programmed criteria, and summarizes the retrieved information for delivery to the subscribing users (Nehab, Abstract, Lines 1-22; Column 3, Lines 15-28 and Lines 50-65; Column 4, Lines 2-12; Column 9, Lines 36-43 and Column 10, Lines 22-28, server retrieves stored personal user profile which includes user defined web site address information, user defined web site command, and user defined formatting command to automatically access, download, extract, and format various web sites into personalized document based on user defined criteria).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the teachings of Nehab and Nazem to summarize the retrieved information from many web sites which are defined and authorized by subscribers, and deliver theses summaries to the subscribers, since it would have provided the capability for searching and obtaining personal information that subscribers need on an Internet server.

However, Nehab does not explicitly disclose personal information is financial information, which is maintained at secure servers.

Gershman teaches Portal server utilize software agents and third party services to respond to customer needs, such a personal news and entertainment, personal shopping, personal finance, personal life insurance, paying bills, etc. (Gershman, Column 34, Lines 60-63; Column 35, Lines 15-20 and Lines 61-65; Column 57, Lines 5-15 and Lines 29-33). Gershman's teaching of obtaining personal finance and bill

payment information online certainly implies the use of secure servers and user authentication.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined Gershman into Nehab and Nazem to provide financial information personal for subscribers through Portal server, since the subscribers would have received many personal information needs from many services such as personal shopping, personal insurance summary, paying bill, etc. besides personalized newspaper of Nehab.

Further, Rao teaches a server automatically logs in to secure server on behalf of and transparent to a subscribing user by using user ID and password (Rao, Abstract and Column 4, Lines 15-24).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined Rao into Gershman, Nehab and Nazem to allow the summary agent of Nehab to automatically log in to the secure servers, such as financial, credit bill, life insurance servers, on behalf of subscribing users, since the agent would have retrieved personal information needs from many kinds of servers for a subscribing server by using the subscribing user's ID and password that is authorized.

Claim 2:

As indicated in the above discussion, Nazem, Nehab, Gershman and Rao teach the limitations of Claim 1.

Nehab teaches a configuration and initiation interface for a subscriber to set up and start a summary search (Nehab, Column 9, Lines 36-43 and Column 10, Lines 37-44).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the teachings of Nehab with Nazem because it would have provided the capability for facilitating searching and obtaining information from an Internet server.

Claim 3:

As indicated in the above discussion, Nazem, Nehab, Gershman and Rao teach the limitations of Claim 1.

Nehab teaches the summary searches are configured for individual clients as templates stored and retrieved at the Internet-connected server (Nehab, Column 7, Lines 27-34).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the teachings of Nehab with Nazem because it would have provided the capability for facilitating storing and retrieving information from an Internet server.

Claim 4:

As indicated in the above discussion, Nazem, Nehab, Gershman and Rao teach the limitations of Claim 1.

Nehab teaches information retrieved in a summary search is to be retrieved by the subscriber (Nehab, Column 10, Lines 22-36).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the teachings of Nehab with Nazem because it would have provided the capability for users to retrieve a summary search.

Claim 5:

As indicated in the above discussion, Nazem, Nehab, Gershman and Rao teach the limitations of Claim 1.

Nehab teaches information retrieved in a summary search is downloaded immediately to the subscriber (Nehab, Column 10, Lines 22-36).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the teachings of Nehab with Nazem because it would have provided the capability for users to view a summary of the desired information.

Claims 7-11:

Claims 7-11 are directed to a method for presenting the system of Claims 1-5, respectively. Thus, Nazem, in view of Nehab, Gershman and Rao, disclose/teach every limitation of Claims 7-11, as indicated in the above rejections for Claims 1-5.

Claims 1-5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen, U.S. Patent No. 6,006,333, in view of Franco et al., U.S. Patent No. 6,687,745.

Claim 1:

Nielsen discloses an Internet Portal, comprising:

- an Internet-connected server (see Figure 1B); and
- a portal software executing on the server (see Column 3, Lines 36-49),

wherein the Portal maintains a list of Internet destinations at secure servers (see element 202, Figure 2) maintaining personal proprietary accounts for each one or more of a plurality of subscribing users (see Column 1, Lines 31-34; see Column 1, Lines 63-65 – many websites have limited access, thus implying that the websites contain “proprietary” information for subscribers to the websites; additionally, the users subscribe to the web sites, and thus information on those web sites is “proprietary” to the users), and the software automatically logs in to the secure servers on behalf of, and transparent to the subscribing users, according to data stored for the subscribing users at the Portal (see Column 2, Lines 18-24), retrieves information proprietary to

each one of the subscribing users (information from web sites is retrieved, and that information is “proprietary” to the users) and stores the retrieved information at the Portal (the “retrieved information” is stored at the Portal in that the web sites are stored on servers), according to pre-programmed criteria (the content provider managing the servers determine the conditions under which and the procedures how the websites are stored).

Nielsen fails to expressly disclose:

- a portal software executing on the server, including a summary software agent, wherein the Portal maintains a list of Internet destinations that maintain proprietary **financial** accounts for subscribing users, retrieves **financial** information proprietary to each one of the subscribing users, stores the retrieved **financial** information at the Portal, and summarizes the retrieved information for delivery to the subscribing users.

Franco teaches portal software executing on the server (see element 64, Figure 1), including a summary software agent, wherein the portal software maintains proprietary financial accounts for users (see Figure 4A – the software “maintains” “proprietary financial accounts” in that it keeps information about stocks owned by the user), retrieves financial information proprietary to each one of the users (see Figures 2 and 4A – the software “retrieves” “proprietary financial information” in that it displays the user’s stock portfolio and trading orders), and summarizes the retrieved information for delivery to the subscribing users (see Figure 4A – the software “summarizes” the retrieved information in that it displays only those stocks chosen for display by the user)

for the purpose of providing links to remotely store information (see Column 4, Lines 25-30).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Internet Portal, disclosed by Nielsen, to include financial information and a summary software agent that summarizes the retrieved information for delivery to the subscribing users, for the purpose of providing links to remotely store information, as taught by Franco.

Claims 2-5:

Nielsen fails to expressly disclose:

- a configuration and initiation interface for a subscriber to set up and start a summary search (see Claim 2);
- summary searches that are configured for individual clients as templates stored and retrieved at the Internet-connected server (see Claim 3);
- information retrieved in a summary search that is retrieved by the subscriber (see Claim 4); and
- information retrieved in a summary search that is downloaded immediately to the subscriber (see Claim 5).

Franco teaches:

- a configuration and initiation interface for a subscriber to set up and start a summary search (see Figures 2 and 4A);

Art Unit: 2179

- summary searches that are configured for individual clients as templates stored and retrieved at the Internet-connected server (see Figures 2 and 4A);
- information retrieved in a summary search that is retrieved by the subscriber (the information retrieved in a summary search is retrieved by the subscriber in that the user chooses which stocks for which information is obtained); and
- information retrieved in a summary search that is downloaded immediately to the subscriber (see Figures 2 and 4A),

for the purpose of providing links to remotely store information (see Column 4, Lines 25-30).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Internet Portal, disclosed by Nielsen, to include:

- a configuration and initiation interface for a subscriber to set up and start a summary search;
- summary searches that are configured for individual clients as templates stored and retrieved at the Internet-connected server;
- information retrieved in a summary search that is retrieved by the subscriber; and
- information retrieved in a summary search that is downloaded immediately to the subscriber,

for the purpose of providing links to remotely store information, as taught by Franco.

Claims 7-11:

Claims 7-11 are directed to a method for presenting the system of Claims 1-5, respectively. Thus, Nielson, in view of Franco, disclose/teach every limitation of Claims 7-11, as indicated in the above rejections for Claims 1-5.

(11) Response to Argument

In the Final Rejection dated 12 August 2004, the examiner set forth two sets of rejections. In the first set, the examiner rejected Claims 1-5 and 7-11 under 35 U.S.C. 103(a) as being unpatentable over Nazem et al., U.S. Patent No. 5,983,227, in view of Nehab et al., U.S. Patent No. 6,029,182, Gershman et al., U.S. Patent No. 6,356,905, and Rao, U.S. Patent No. 6,078,929. In the second set, the examiner rejected Claims 1-5 and 7-11 under 35 U.S.C. 103(a) as being unpatentable over Nielsen, U.S. Patent No. 6,006,333, in view of Franco et al., U.S. Patent No. 6,687,745.

Appellant's arguments are numbered in the Appeal Brief. Argument #1 is against the rejections of Claims 1-5 and 7-11 under 35 U.S.C. 103(a) as being unpatentable over Nazem, in view of Nehab, Gershman, and Rao. Arguments #2 and #3 are against the rejections of Claims 1-5 and 7-11 under 35 U.S.C. 103(a) as being unpatentable over Nieslen, in view of Franco.

The examiner notes that, in Argument #1, Appellant appears to argue against the references individually by separating the Gershman reference from the other references used to make the 103 rejections, and in Argument #2, Appellant appears to argue

against the references individually by separating the Nielsen reference from the Franco reference in the 103 rejections. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Argument #1 in regard to the 103 rejection based on Nazem, in view of Nehab, Gershman and Rao:

Appellant argues that Gershman fails to teach retrieving, storing and summarizing proprietary financial information, and that the “personal” aspects of the system/service relate to the personal information stored in the user’s profile. See *Appeal Brief* – Page 8, second paragraph, first sentence.

The examiner disagrees.

The examiner does not use Gershman to teach *storing* and *summarizing* proprietary financial information. Gershman is used to teach *only retrieving* proprietary financial information. Gershman teaches “retrieving proprietary financial information” in that it expressly discloses “online bill paying” (see Gershman – Column 34, Lines 60-63). In order to allow the user to pay bills online, “proprietary financial information” for the user must be retrieved.

In support of Appellant's argument, Appellant argues that the fact that Gershman teaches the use of "trusted" agents, which may err on the side of privacy of information, rather than on the side of stimulation of commerce, certainly does not express or indicate that **proprietary** financial information is retrieved. Appellant states that "the information retrieved and stored by the agents on behalf of the subscribing user is not owned solely by the subscribing user," but rather, it is "personal" information that may be viewed and utilized by others who are not "trusted." See *Appeal Brief* – Page 8, third paragraph, first and second sentences.

The examiner disagrees.

The relevant claim language is:

"wherein the Portal maintains a list of Internet destinations at secure servers maintaining personal, proprietary financial accounts for each one or more of a plurality of subscribing users, and the summary software agent automatically logs in to the secure servers on behalf of and transparent to the subscribing users, according to data stored for the subscribing users at the Portal, retrieves financial information proprietary to each one of the subscribing users, stores the retrieved financial information at the portal, according to pre-programmed criteria, and summarizes the retrieved information for delivery to the subscribing user"
(see Claim 1, Lines 5-12).

This claim language is open-ended and does not require that the "proprietary" information be "owned solely by the subscribing user". Thus, in this argument, Appellant is interpreting the meaning of the term "proprietary" too narrowly.

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During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The examiner cannot locate a definition of the term "proprietary" in the specification. Thus, the examiner gives the term its plain meaning as follows: "of or relating to a proprietor" or "exclusively owned; private" (*The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company). This definition of the term "proprietary" is applied everywhere the term is used in this Examiner's Answer.

The information required to pay bills online is "proprietary" to the user in that the information belongs to the user. That is, the user is the "owner" of the information. For example, the user is the "owner" of: 1) the bills that are paid; and 2) the checking account or credit card that is used to pay the bills. This information owned by the user is both "proprietary" and "financial."

Moreover, Appellant impliedly admits that the information retrieved by the "trusted" agents of Gershman is at least partly "owned" by the subscribing user and

expressly admits that the information is “personal” (see *Appellant’s Appeal Brief* – Page 8, third paragraph, second sentence).

In support of Appellant’s argument, Appellant states that the agent is able to go online and pay bills for the subscribing user *without* retrieving financial information proprietary to the subscribing user. See *Appellant’s Appeal Brief* – Page 9, first partial paragraph, first complete sentence.

The examiner disagrees.

In order for the agents in Gershman to pay bills for subscribing users, the agents must retrieve financial information that is “proprietary” to the subscribing user. For example, the agent must access a user’s account at the creditor’s database to find out how much the user owes the creditor. This information is both “financial” and “proprietary” to the user.

Appellant appears to argue against the references individually by separating the Gershman reference from the other references used to make the 103 rejections. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Finally, any novelty of Appellant's invention should not be based upon the type of information that is processed. Instead, any novelty that is determined must come from the **methods used** to process that information. In the present case, the Appellant's invention is not novel and unobvious because the prior art discloses/teaches the "automatic login" feature and/or the "summarization" feature of Appellant's invention with proper motivation to combine those features.

Argument #2 in regard to the 103 rejection based on Nielsen, in view of Franco:

Appellant argues that Nielsen fails to disclose **proprietary** information because having a subscription for accessing information on a website does not make that website information "proprietary." Appellant further argues that Nielsen fails to disclose **proprietary** information because the information is accessible to others without authorization. See *Appeal Brief* – Page 9, third full paragraph, second sentence through Page 10, first partial paragraph, first complete sentence.

The examiner disagrees.

Nielsen expressly discloses: 1) the proliferation of limited access websites on the World Wide Web (see Nielsen – Column 1, Lines 31-34); and 2) that users subscribe to websites (see admission in *Appeal Brief* – Page 9, third full paragraph, second sentence). By "subscribing" to a "limited access" website, the user becomes a "**proprietor**" of the information at that website. Thus, the website information disclosed in Nielsen is "proprietary."

Finally, even if the website information disclosed in Nielsen were “accessible to others without authorization,” this would not negate the fact that the subscribing user is a “proprietor” of the website information.

Appellant appears to argue against the references individually by separating the Nielsen reference from the Franco reference in the 103 rejections. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Argument #3 in regard to the 103 rejection based on Nielsen, in view of Franco:

Appellant argues that Franco fails to teach maintaining **proprietary** financial information because: 1) the disclosed software is for a “droplet” application that allows the user to create an interactive interface for accessing remote information; and 2) Franco does not expressly state that the displayed stocks and trading orders shown in Figure 4A are owned by the subscribing user. See *Appellant’s Response* – Page 10, second full paragraph through Page 11, first partial paragraph, second complete sentence.

The examiner disagrees.

The express, implicit and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. Thus, any implied

teaching found in Franco can be properly used in a rejection based on the prior art. Franco might be a patent for the “droplet” software, but it is a reference for everything that it expressly, implicitly and inherently discloses.

Franco expressly states that the invention retrieves applications and information from a remote source (see Franco – Column 4, Lines 43-47) and allows the user to selectively re-establish connection to the remote source for invoking and presenting the remotely stored applications and information on an as-needed basis (see Column 5, Lines 5-9). Figures 2 and 4 show the “Stock Watcher” application, which displays a user’s trading orders (see Figure 2) and current statistics for stocks (see Figure 4). The cited text and figures imply that a user may review and update his trading orders on an as-needed basis. Additionally, the trading orders are certainly “proprietary” to the user in that the orders are “owned” by the user and unknown to third parties.

Moreover, the cited figures and text impliedly disclose that a user of the software also “owns” the stocks for which trading orders are given (see Figure 2) and current statistics are displayed (see “Portfolio” tab in Figure 4). For example, in order to sell a stock (as specified in a “sell” order), the seller must **own** the stock. Also, a user’s stock “portfolio” comprises stocks **owned** by the user.

Accordingly, Franco teaches maintaining proprietary financial information.

Appellant argues that Franco fails to teach “retrieving” “proprietary financial information” because the information displayed in Figure 4A of Franco is not specifically

taught to be the user's stock portfolio and trading orders. See *Appeal Brief* – Page 11, first full paragraph.

The examiner disagrees.

As indicated in the above discussion, Franco at least impliedly teaches retrieving proprietary financial information. Appellant's arguments regarding the definition of the term "proprietary" have been fully addressed and will not be repeated here.

Appellant appears to argue against the references individually by separating the Franco reference from the Nielsen reference in the 103 rejections. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

WDH
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